

REMARKS

Applicants appreciate the Examiner's indication by telephone call of April 28, 2008, that the proposed claim construction used in examining this application hinged on an improper application of MPEP 2114.

In this regard, the Office Action took the position that the majority of the recitations of the claims were not held to be limiting and only the features of "a projection system," "a sensor," "a processing unit," and "a beam generator" were examined. Applicant respectfully submits that this is improper. "There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971)." *See* MPEP §2173.05(g). "A functional limitation **must be evaluated and considered, just like any other limitation of the claim**, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." *Id.* (Emphasis added). Functional language such as "adapted to" has been held to define present structural attributes of interrelated component parts. *See, In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976). Applicants respectfully submit that it is the case here. By way of example, claim 11 recites that the sensor is "arranged to measure positional parameters for each of the plurality of alignment marks ... and to transfer the measured positional parameters to the processing unit," thereby interrelating the sensor structurally, by its position and its ability to transfer information to the processing unit, to the alignment marks and to the processing unit respectively. Similar analysis applies to the remaining recitations.

In view of the proper construction of the claims, Applicants submit that the art cited fails to teach or suggest each and every limitation of at least claim 11 and that the Office Action has not set out a proper *prima facie* case. Applicants therefore request that the rejections of claims 11-17 under 35 U.S.C. §102(b) be withdrawn.

VAN DER SCHAAR ET AL. -- 10/730,254
Attorney Docket: 081468-0307120

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

PILLSBURY WINTHROP SHAW PITTMAN LLP

A handwritten signature in black ink, appearing to read 'RCP', with a long horizontal flourish extending to the right.

ROBERT C.F. PEREZ
Reg. No. 39328
Tel. No. 703.770.7759
Fax No. 703.770.7901

Date: June 9, 2008
P.O. Box 10500
McLean, VA 22102
(703) 770-7900